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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,503	03/26/2004	Masayuki Tsuda	9683/177	8171
757 7590 06/12/2007 BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			EXAMINER YOUNG, NICOLE M	
			ART UNIT 2139	PAPER NUMBER
			MAIL DATE 06/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/810,503	Applicant(s) TSUDA ET AL.	
	Examiner Nicole M. Young	Art Unit 2139	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :06/21/2004, 02/27/2006, 04/04/2006. 04/16/2007.

DETAILED ACTION

The Applicant uses the language "means for" throughout the claim language.

The Examiner considers 112 6th paragraph to be invoked.

Claim Objections

Claim 5 is objected to because of the following informalities:

The language of the claim is unclear. In particular, the Examiner finds "a program product for causing a computer device storing data and restriction data for identifying instruction code whose execution is restricted, to execute the steps of" to be unclear.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "storing means", "execution means", "determination means", and "prevention means". As 112 6th paragraph is considered to be invoked, each of these "means for" statements must have a specific physical structure in the specification. The Examiner cannot determine this from the specification. Claims 2-4 are dependent claims that further describe claim 1 and/or add more "means for" language that does not have specific physical structure in the specification, therefore they are rejected as well.

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Further, in claim 1 there are two storage means listed. However, there are multiple storage locations mentioned in the specification. It is unclear to the Examiner which storage location is being referred to by each storage means. Claims 2-4 are dependent claims that do not further clarify which storage location is being used, therefore they are rejected as well.

Claim 1 refers to a "first storage means for storing data" and a "second storage means for storing data". Later in the claim it states "at least a part of the data". It is unclear to the Examiner which data the later part of the claim is referencing. Claims 2-4 are dependent claims that do not further clarify which data is being used, therefore they are rejected as well.

Claims 1 and 5 refer to "preventing execution of the instruction code". It is unclear from the specification and claims how the invention prevents the execution of the instruction code. Claims 2-4 are dependent claims that do not further clarify, therefore they are rejected as well.

The language of claim 2 is unclear to the Examiner and does not particularly point out the subject matter it is claiming. The lines "only in a case where the application program executed by the execution means is an application program for which it is not confirmed that the application program will not carry out operations that are inconvenient to a user" is particularly unclear. The Examiner interprets this claim to be installing the executables when it is convenient for the user.

Claim 4 states "the first storage means stores identifiers representing whether data requires security protection, in association with the data". It is unclear which data is being referred to by each instance.

Claim 5 states "storing data and restriction data" and later states "at least some of the data will be accessed". It is unclear which data is later accessed.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Specifically, Claim 5 is directed to "a computer program product". Generally, functional descriptive material, such as a computer program, is statutory when it is stored on a tangible computer readable medium. See MPEP § 2106 IV.B.I(a). However, in the present application there is no tangible computer readable medium. A computer program listing on a sheet of paper is not considered to provide functionality, and is therefore considered to be merely a computer program per se, which is non-statutory subject matter. When a claim encompasses both statutory and non-statutory subject matter, the claim as a whole is directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Touboul (US 6,092,194).

Claim 1 discloses a terminal device (Figure 1, Internal Network Security System 110), comprising:

first storage means for storing data (Figure 2, RAM 235);

execution means for executing instruction code in accordance with an application program (Figure 2, CPU 205);

second storage means for storing data for specifying, among instruction codes that can be executed by the execution means, instruction codes whose execution is restricted in the terminal device (Figure 2, Data Storage Device 230 and Figure 3 which is an extension of Figure 2, Security Database 240 within Data Storage Device 230; Further explanation is found in column 3 lines 42-66 and column 4 lines 1-12. These disclose a second storage device that has a restriction database.);

determination means for determining whether an instruction code executed by the execution means in accordance with an application program is a restricted instruction code, based on a stored content of the second storage means (Figure 2, Data Storage Device 230 and Figure 3 which is an extension of Figure 2, Security Database 240 within Data Storage Device 230; Further explanation is found in column 3 lines 42-66 and column 4 lines 1-12. These disclose a second storage device that determines if the Downloadable is suspicious); and

prevention means for preventing execution of the instruction code by the execution means when it is determined by the determination means that execution of an

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instruction code is restricted, and at least a part of the data will be accessed by execution of the instruction code (Column 3 lines 9-22, discloses preventing suspicious Downloadables from being executed).

Claim 2 discloses the terminal device according to claim 1, wherein the determination means further determines whether instruction code executed in accordance with the application code is instruction code whose execution is restricted based on stored content of the second storage means, only in a case where the application program executed by the execution means is an application program for which it is not confirmed that the application program will not carry out operations that are inconvenient to a user (Figure 2, Data Storage Device 230 and Figure 3 which is an extension of Figure 2, Security Database 240 within Data Storage Device 230; Further explanation is found in column 3 lines 42-66 and column 4 lines 1-12. These disclose a second storage device that determines if the Downloadable is suspicious. Also column 7 lines 30-45, discloses a user notification engine sending an email regarding Downloadables to the user or displaying a message on the user's screen).

Claim 3 discloses the terminal device according to claim 1, wherein:

the terminal device further comprises communication means for communicating via a communications network (Figure 2, External Communications Interface 210; Also column 2 lines 66-67 and column 3 lines 1-9); and

the determination means determines whether instruction code executed in accordance with the application code is instruction code whose execution is restricted based on stored content of the second storage means, only in a case that the

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application program executed by the execution means is an application program acquired via a communications network using the communication means ((Figure 2, Data Storage Device 230 and Figure 3 which is an extension of Figure 2, Security Database 240 within Data Storage Device 230; Further explanation is found in column 3 lines 42-66 and column 4 lines 1-12. These describe a second storage means that restricts Downloadables from the Internet (as disclosed in column 2 lines 66-67 and column 3 lines 1-9).

Claim 4 discloses the terminal device according to claim 1, wherein:

the first storage means stores identifiers representing whether data requires security protection, in association with the data (Figure 1 discloses the first storage device RAM 225 contains Security Program 255. The Security Program 255 includes an ID generator as described in column 3 lines 62-66); and

the prevention means prevents execution of the instruction code by the execution means when it is determined by the determination means that there is instruction code whose execution is restricted, and that if the instruction code is used at least some data stored in the first storage means associated with an identifier for protecting security will be accessed by the instruction code (Column 4 lines 14-28).

Claim 5 discloses a program product for causing a computer device storing data and restriction data for identifying instruction code whose execution is restricted, to execute the steps of (column 2 lines 22-28):

executing instruction code in accordance with an application program (Figure 2, CPU 205 and column 3 lines 42-61 disclose execution);

determining whether an instruction code executed by the execution means in accordance with an application program is a restricted instruction code, based on stored content of the computer (Figure 2, Data Storage Device 230 and Figure 3 which is an extension of Figure 2, Security Database 240 within Data Storage Device 230; Further explanation is found in column 3 lines 42-66 and column 4 lines 1-12. These disclose a second storage device that determines if the Downloadable is suspicious); and

preventing execution of the instruction code by the execution means when it is determined by the determination means that execution of an instruction code is restricted, and at least some of the data will be accessed by execution of the instruction code (Column 3 lines 9-22, discloses preventing suspicious Downloadables from being executed).

Note: Examiner has pointed out particular references contained in the prior arts of record and in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. Applicant should consider the entire prior art as applicable to the limitations of the claims. It is respectfully requested from the applicant, in preparing for response, to consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the Examiner.

Conclusion

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicole M. Young whose telephone number is 571-270-1382. The examiner can normally be reached on Monday through Friday, alt Fri off, 8:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NMY
6/06/2007


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PRIMARY EXAMINER
6/18/07